


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q86666	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/530,515	April 7, 2005	
	First Named Inventor		
	Takenobu SUNAGAWA		
	Art Unit	Examiner	
	1713	Michael Bernshteyn	
WASHINGTON OFFICE 23373 CUSTOMER NUMBER			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal			
The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
<input checked="" type="checkbox"/> I am an attorney or agent of record.			
Registration number		40,641	
		 Signature	
		Jennifer M. Hayes Typed or printed name	
		(202) 293-7060 Telephone number	
		August 27, 2007 Date	

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q86666

Takenobu SUNAGAWA, et al.

Appln. No.: 10/530,515

Group Art Unit: 1713

Confirmation No.: 5345

Examiner: Michael Bernshteyn

Filed: April 7, 2005

For: THERMOPLASTIC POLYESTER RESIN COMPOSITION AND MOLDED ARTICLE
COMPRISING THE SAME

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Program, and further to the Examiner's Final Office Action dated April 26, 2007, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal and a Petition for Extension of Time and the required fees. The Request is timely filed with a one month petition for extension of time on August 27, 2007 (August 26, 2007 being a Sunday).

Applicant turns now to the rejections at issue.

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable as obvious over Watanabe et al (U.S. Patent 6,44,913) in view of Ding et al (CN 1123302 A).

The Examiner relies on Watanabe as stated in the Actions on the record. The Examiner relies on Ding et al as disclosing a viscosity modifier for acrylic and other resins, consisting essentially of (a) 10-30% alkyl(meth)acrylate containing an epoxy group; (b) 40-70% of another

alkyl(meth)acrylate; and (c) 10-40% by weight of another vinyl monomer copolymerizable therewith. Ding et al was also cited as disclosing a weight average molecular weight of 1,000-10,000 within the claimed range.

Applicants respectfully traverse the rejection.

The present claims relate to a thermoplastic resin composition comprising (1) a thermoplastic resin and (2) a viscosity modifier for the thermoplastic resin wherein the viscosity modifier consists essentially of components (a), (b) and (c) as recited in claim 1.

Watanabe as a whole does not fairly teach or suggest the combination of the viscosity modifier and core-shell graft polymer as recited in independent claim 1 for the reasons of record. Additionally, Ding et al does not remedy the deficiencies of Watanabe.

Watanabe merely discloses various kinds of thermoplastic elastomers and core-shell polymers as impact resistance modifiers. Watanabe does not specifically mention a thermoplastic elastomer and a core-shell polymer in combination. Specifically:

(1) at column 3, lines 34-48 relied on by the Examiner, Watanabe discloses each of thermoplastic elastomers and core-shell polymers as individual examples of impact resistance rendering materials (B) and not as a combination; (2) no such combination is employed in the working examples disclosed in Watanabe (e.g., none of the seventeen (17) inventive examples or fifteen (15) comparative examples employs a combination of a thermoplastic elastomer and a core-shell polymer as component (B) of Watanabe); and (3) Watanabe does not recognize the synergistic effect obtainable from the combination of the specific viscosity modifier for a

thermoplastic polyester resin and core-shell polymer as shown by the data provided in the specification.

In response to Applicants arguments regarding the disclosure of Watanabe, the Examiner states that Watanabe discloses that typical examples of impact resistance rendering materials (B) include thermoplastic elastomers and core-shell polymers. The Examiner also refers to the disclosure of Watanabe which teaches that “thermoplastic elastomer” is a generic term for polymeric substances, which are solids exhibiting rubber-like elasticity at ordinary temperature but are fusable with thermoplastic resins because the viscosity is reduced with an aid of heat and addition of the component (B) leads to decrease in the internal stress generated in the resin, which makes it possible to inhibit the development of cracks in alkaline solutions.

However, the concepts of a “viscosity modifier” and “thermoplastic elastomer” are completely different. The term “thermoplastic elastomer” refers to physical properties or characteristics of a material such as plastics, whereas the term “viscosity modifier” as used in the present application refers to the utility of a material. Also, in the present application, the “viscosity modifier” is not a “thermoplastic elastomer” as is clear from the present claims which recite that the “viscosity modifier” of the present invention consists essentially of units (a), (b) and (c) as recited in present claim 1.

With respect to the comments made by the Examiner in the Advisory Action dated July 31, 2007 that the claims do not recite the feature of a synergistic effect obtainable from the combination of the specific viscosity modifier for a thermoplastic polyester resin and core-shell polymer, Applicants have already pointed out to the Examiner that there is no requirement to

recite such a synergistic effect in the claims and the synergistic effect is effectively demonstrated in the examples in the present specification. See, e.g., the paragraph bridging pages 9-10 of the Amendment filed December 21, 2006.

Moreover, Ding et al does not teach that the composition disclosed therein can be used as a viscosity modifier in the abstract as stated by the Examiner. Ding et al is completely silent as to a viscosity modifier and there is no objective reason for one of ordinary skill in the art to use the composition taught by Ding et al as a viscosity modifier. As is apparent from the English translation of Ding et al (attached to the Office Action dated April 26, 2007), Ding et al does not teach, suggest or even mention a thermoplastic resin composition comprising a thermoplastic polyester resin and a viscosity modifier. Ding et al is silent as to a viscosity modifier and therefore can not be said to teach a viscosity modifier consisting essentially of units (a), (b) and (c) as recited in present claim 1. Thus, even if the references were combinable (a point Applicants do not concede), the resulting combination would not achieve the present invention.

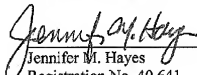
.Additionally, contrary to the Examiner's assertion, there is no apparent reason to combine the Watanabe and Ding et al in the first instance. This is because Ding et al relates to a resin for the preparation of an acroleic powder coating, which is a decorative outdoor coating, whereas Watanabe relates to thermoplastic resins used for engineering plastics for cars and electrical/electronic apparatuses. Therefore, a person skilled in the art would not have been motivated to combine Watanabe with Ding et al with a reasonable expectation of success in achieving the claimed invention. Thus, the present invention is not rendered obvious by the cited references.

Further, the Examiner's position that Watanabe and Ding et al are from the same field of endeavor concerning new polymerizable composition as a viscosity modifier is unreasonable since Ding et al does not teach, mention or suggest a viscosity modifier. Ding et al is silent as to a viscosity modifier and the Examiner engages in improper hindsight reasoning in suggesting the combination of the references.

Accordingly, Applicants submit the Examiner has not made a *prima facie* showing of obviousness and the present invention is not rendered obvious by the cited references.

In view of the above, Applicants respectfully request the Pre-Appeal Brief Conference Panel to withdraw the foregoing rejection in view of clear error in that the prior art references do not disclose, teach or suggest the presently claimed invention.

Respectfully submitted,


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